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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,370	01/05/2001	Linlin Xing	0084-0221P	3522

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EXAMINER

HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

# Office Action Summary

Application No. 09/754,370	Applicant(s) Xing et al.
Examiner Bruce Hess	Group Art Unit 1774

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-25 are subject to restriction and election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, drawn to a process of making and product by process, classified in class 156, subclass 235.
  - II. Claims 17-19, drawn to articles, classified in class 428, subclass 195.
  - III. Claims 20-25, drawn to methods of use and imaged articles, classified in class 427, subclass 152.

2. The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the article of Group II can be made by another materially different process (e.g., coextrude the ink receptive composition and substrate or cast the ink-receptive composition and bond it to the substrate).

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the article of Group II can be used in a materially different process of using that product (e.g., thermoform the composite into a container or image the composite with a sublimation dye).

Finally, the composite recited in Groups II and III does not require the specific melt-extrudable compounds recited in Group I.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. In the event of the election of the Group I invention above, the following election of species is also required.

This application contains claims directed to the following patentably distinct species of the claimed invention: Method of making and article made wherein the extruded material is

A. A single ink-receptive layer containing

- 1 Poly (2-ethyl-2-oxazoline) (claim 2);
2. A hydrolyzed copolymer of ethylene and vinyl acetate;
3. Ethylene/methacrylic acid copolymers (claims 3 and 4); or
4. Both poly (2-ethyl-2-oxazoline and ethylene/acrylic acid copolymer (claim 5);

B. Multiple ink-receptive layers wherein the first layer contains

1. Poly (2-ethyl-2-oxazoline);
2. A hydrolyzed copolymer of ethylene and vinyl acetate; or
3. Ethylene/acrylic acid copolymers or ethylene/methacrylic acid copolymers;

And the second layer contains

4. Poly (2-ethyl-2-oxazoline);
5. A hydrolyzed copolymer of ethylene and vinyl acetate; or
6. Ethylene/acrylic acid copolymers or ethylene/methacrylic acid copolymers; or

C. A tie layer, moisture barrier layer and a single ink-receptive layer containing

- ① Poly (2-ethyl-2-oxazoline);

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2. A hydrolyzed copolymer of ethylene and vinyl acetate; or
3. Ethylene/acrylic acid copolymers or ethylene/methacrylic acid copolymers.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. In the event of the election of ~~the~~ Group III invention, the following election of species is also required.

This application contains claims directed to the following patentably distinct species of the claimed invention: Methods of use and resulting articles wherein the composite medium is

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- A. Imaged only (claims 20 and 23-25); or
- B. Imaged and bonded (claims 21 and 23).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Consequently, applicants should elect one of Groups I-III. In the event of the election of Group I, they should additionally elect (a) any one of species A<sub>1-4</sub>, (b) any one of species B<sub>1-3</sub>

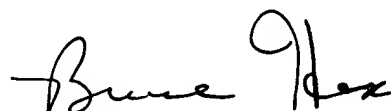
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and any one of species B<sub>4-6</sub> or (c) any one of species C<sub>1-3</sub>. In the event of the election of Group III, they should additionally elect either species A or species B.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Examiner Hess/ng

July 1, 2002

A handwritten signature in black ink, appearing to read "Bruce Hess", with a stylized flourish at the end.

BRUCE H. HESS  
PRIMARY EXAMINER